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In re Application of
McWethy
Application No.: 10/532,526 : DECISION
PCT No.: PCT/US03/33511 :
Int. Filing Date: 23 October 2003 : ON
Priority Date: 06 November 2002 :
Attorney Docket No.: 1032-P02946US1 : PETITION
For: Pre-Filled Retractable Needle Injection Device :
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This is in response to the petition under 37 CFR 1.47(b) filed on 27 December 2005.

BACKGROUND

This international application was filed on 23 October 2003, claimed an earlier priority date of 06 November 2002, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 06 May 2005. Applicants filed *inter alia* the basic national fee on 25 April 2005.

On 23 September 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(h).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Regarding requirement (1), petitioner paid \$130.00 toward the petition fee on 27 December 2005. The remaining \$70.00 is being charged to counsel's Deposit Account No. 04-1406, as authorized by the Transmittal Letter filed on 25 April 2005.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of sole inventor Robert McWethy be excused because he allegedly "cannot be found or reached after diligent effort." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort

was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37 CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

Counsel has not adequately substantiated his assertion that Mr. McWethy "cannot be found or reached after diligent effort" under the standard enunciated above. Petitioner asserts that he forwarded a copy of the instant patent application to Mr. McWethy's last known address, along with a declaration and an assignment. Petitioner further asserts that, in response to this letter, he was contacted by telephone by an individual who purported to have purchased Mr. McWethy's former residence and "did not know where Robert McWethy had moved to." Counsel states that he "performed several computer searches in an attempt to locate Robert McWethy, but was unable to locate a new address for him." Similarly, counsel states that computer searches were performed in an attempt to identify a telephone number and an e-mail address for Mr. McWethy. These statements are insufficient because petitioner has not provided appropriate documentation (such as print-outs) of such searches (i.e., search software and search terms used, printouts of search results, etc.). It is noted that neither Exhibit B nor Exhibit C, referenced by the petition, is currently present in the application file. In the absence of an adequate showing of the specific efforts undertaken to find or reach Mr. McWethy, it would be inappropriate to conclude that he "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(b).

Regarding requirement (3), the petition includes a statement the last known address of Mr. McWethy. Accordingly, requirement (3) has been satisfied.

Concerning requirement (4), the instant renewed petition is accompanied by a declaration executed on behalf of Mr. Robert McWethy by Joseph N. Bongiovanni, who is identified as "Representative of MDC Research Limited" and as "Secretary." The document further states that "I am authorized to act on behalf of MDC Research Ltd." This declaration satisfied requirement (4).

Regarding requirement (5), petitioner argues that Mr. McWethy was obliged to "assign to MDC Research Ltd. all inventions designed or developed during the course of his work with MDC Research Ltd. Copies of the portion of the agreement dealing with the work product are attached hereto as Exhibit A." MPEP 409.03(f) provides in part that

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or

(C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Upon review of the application file, the evidence petitioner refers to as Exhibit A does not appear to be present at this time. In the absence of a showing of the alleged proprietary interest of MDC Research Ltd. in this application, it would be inappropriate to conclude that requirement (5) has been satisfied.

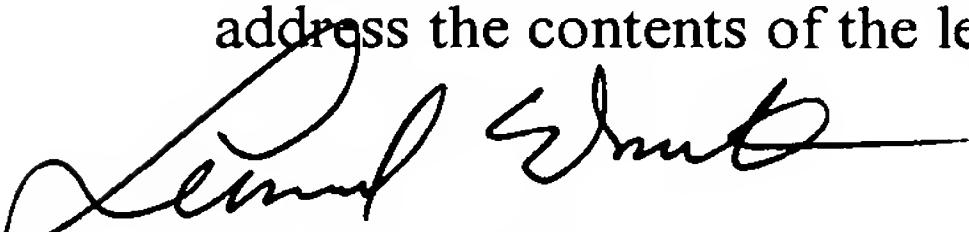
Regarding requirement (6), the petition lacks any showing or assertion that the requested action is necessary to preserve the rights of the parties or to prevent irreparable damage. Therefore, requirement (6) has not been satisfied at this time.

DECISION

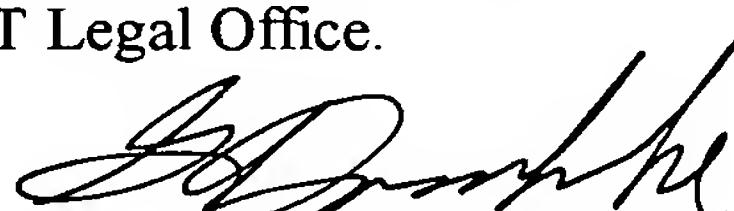
The petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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